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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,824	06/15/2001	Masaya Umemura	500.4021400	6606

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MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,824

Applicant(s)

UMEMURA ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6,8-11 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,6,8-11 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 6/28/2005 is acknowledged and entered. Claims 1-4, 7, 12 and 13 have been canceled. Claims 5, 10, 11, 15 and 16 have been amended. New Claims 17-19 have been added. Claims 5, 6, 8-11 and 14-19 are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, 8-11, 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyashita (US 5,397,883) in view of Sehr (US 6,085,976).

Clam 5. Miyashita teaches an automatic ticket-examining apparatus for more than one medium, comprising:

a ticket examiner (ticket examining apparatus) (C. 3, L. 16);

an information processing apparatus (a controller (41) comprising a central processing unit (42)) interconnected with said ticket examiner for providing a passenger an access to a railroad (a service) in compensation to a payment (C. 4, L. 42-51; C. 1, L. 12);

wherein said ticket examiner prohibit a passenger from entering or leaving a railroad station (isolates a service providing location from a service free location) (C. 1, L. 18-19);

wherein said ticket examiner comprises:

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communication means (91) provided on a surface of said ticket examining apparatus (Fig. 1) and based on non-contact electromagnetic contact scheme with a user's medium (radio commuter pass) which is mobile (C. 3, L. 44-52);

means for collecting information and means for settling a service provided through said communication means based on information stored in said user's medium (radio commuter pass) (C. 5, L. 1-9);

wherein said ticket examiner (ticket examining apparatus) further comprises:

person sensing means (C. 5, L. 4); and

means for recognizing based on a person sensed by said person sensing means and said user's medium (the radio commuter pass) sensed by said communication means that a user who should receive a service exists at said ticket examiner (C. 3, L. 53-64).

Miyashita does not specifically teach that said information processing apparatus comprises means connected to a financial institution for decrypting said collected information on said settling means to a plain text, making a settlement based on said evaluation through said financial institution and said communication means. Also, Miyashita does not specifically teach means for issuing a ticket.

Sehr teaches a travel system utilizing multi-application passenger card, including a passenger station that controls access to a railroad, said station is equipped with smart card reader/writer units; a travel center that provides the computerized means for the selection, payment and issuance of passenger cards (means for issuing a ticket), said travel center coupled to said station; and Bank/Financial Institution that facilitates the electronic process between the passenger and travel centers (service provider), said Bank/Financial Institution is coupled to said travel center (Fig. 2; C. 7, L. 25-57); and Encrypt/Decrypt means for encrypting or decrypting uploaded or downloaded card-related data (C. 19, L. 6-12), wherein the compiled information can be loaded into the card in a text form (C. 10, L. 16-21).

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It would have been obvious to one having ordinary skill in the art to modify Miyashita to include means connected to a financial institution for decrypting said collected information and making a settlement based on said evaluation through said financial institution, as disclosed in Sehr, because it would advantageously provide security for the system by preventing possible financial fraud. And it would have been obvious to one having ordinary skill in the art to modify Miyashita and Sehr to include means for issuing a ticket, as disclosed in Sehr, because it would provide convenience for the passenger to obtain a new ticket at the gate if a passenger's old ticket is unacceptable.

Claim 6. Sehr teaches means for issuing a ticket (C. 7, L. 31), wherein user's medium is referred to upon exiting of said user at the passenger station (C. 23, L. 42-46). The motivation to combine Miyashita with Sehr would be to conveniently allow the passenger to obtain a new ticket at the gate if a passenger's old ticket is unacceptable.

Claim 8. Miyashita teaches said ticket examiner, including a person sensor (with a long distance service area) (C. 5, L. 4), and an antenna disposed on a surface of said ticket examiner (C. 3, L. 44-52).

Claim 9. Miyashita teaches said an antenna disposed on a surface of said ticket examiner approached by the passenger (C. 3, L. 44-52);

wherein said person sensor appears to detect passengers coming out of a service area (railroad station) and passengers coming to the service area (from service-free area) (said ticket examiner prohibits or allows the passenger from entering or leaving the station (C. 1, L. 18-19);

wherein said ticket examiner communicates with a passenger card present in both service and service-free areas, and refers to information stored in said card through said antenna (C. 6, L. 41-45);

wherein said ticket examiner tries to communicate with the passenger card using a person sensor to detect arrival of the passenger (C. 5, L. 4); and

wherein if presence of the passenger is detected, said ticket examiner successively refers to information stored in said passenger card through said antenna (C. 6, L. 41-45).

Claim 10. Miyashita teaches that said ticket examiner includes a gate for blocking the passenger from entering or leaving the station when the ticket is found to be non-valid (C. 1, L. 15-19).

Claim 11. Sehr teaches Encrypt/Decrypt means for encrypting or decrypting uploaded or downloaded card-related data (C. 19, L. 6-12). The motivation to combine Miyashita with Sehr would be to advantageously provide security for the system by preventing possible financial fraud.

Claim 14. Miyashita teaches means for judging information stored in the passenger card (C. 7, L. 61-65) and gates for blocking the passenger from leaving the station if said means for judging indicates abnormality with said information (C. 1, L. 18-19). Sehr teaches means for checking validity of information stored on the passenger card, wherein said information includes position information (C. 23, L. 42-46). The motivation to combine Miyashita with Sehr would be to advantageously provide security for the system by preventing possible fraudulent use of said card.

Claim 15. Miyashita teaches said system, wherein, upon establishing communication with a user's medium by said communication means, the ticket examiner transmits identification information provided for each user, the number of past passes through the ticket examiner and information on getting on and off to the user's medium (C. 7, L. 63; C. 8, L. 11-16). Information as to: "wherein, upon establishing communication with a user medium, the ticket examiner transmits a synchronizing clock to the user medium" indicates the intended use of the system, and does not recite a structural element. Therefore, said information is given no patentable weight. MPEP 2106 (II) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation."

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Furthermore, Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of Claim 15 are disclosed in Miyashita in view of Sehr as described herein. Also, as described, the limitations of Claim 15 do not distinguish the claimed apparatus from the prior art.

Claim 16. Miyashita teaches said system, wherein said communicating means transmits a request for communication to a user medium using an antenna when a proximity detector detects presence of a passenger (C. 5, L. 1-9, 28).

Claim 17. Sehr teaches said system including a printer (ticket issuing means) for printing paper tickets (C. 7, L. 10-11). The motivation to combine Miyashita and Sehr would be to decrease operational cost of the system by using inexpensive medium for the tickets.

Claim 18. See reasoning applied to Claim 5. Information as to "wherein said ticket issuing means, after said settling, generates printing data and magnetic recording data for said ticket" indicates the intended use of the system and does not recite a structural element. Furthermore, regardless that the disclosed system is capable of providing such functionality (Miyashita teaches a magnetic information recording section (C. 4, L. 31-33) and Sehr teaches a printer (ticket issuing means) for printing tickets (C. 7, L. 10-11; C. 10, L. 19-21)), there is no indication in the Claim of further use of said generated data. Therefore, said information is given no patentable weight. MPEP 2106 (II) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a Claim to a particular structure does not limit the scope of a Claim or Claim limitation."

Claim 19. Miyashita teaches said ticket examiner, comprising a ticket inlet (ticket slot 14, C. 3, L. 15-21) and a magnetic information recording section (C. 4, L. 31-33). Sehr teaches a printer (ticket issuing means) for printing paper tickets (C. 7, L. 10-11). The motivation to combine Miyashita and Sehr would be to decrease operational cost of the system. Information as to "wherein said ticket issuing means checks whether a ticket is entered into a ticket inlet of said ticket examiner, and *if not* entered, writes said printing data and said magnetic recording data on a slip of paper and issues the slip of paper as a ticket, and said issuing means calls said user medium, and *if a response is received* from said user medium, writes said printing data and said magnetic recording data on a slip of paper and issues the slip of paper as a ticket" indicates the intended use of the system. Furthermore, the use of conditional clause (if then) implies providing alternative method steps, which are not recited in the Claim. The Claim does not provide any indication of what happens if *the ticket is entered*, or what happens if *a response is received*. Therefore, regardless that the disclosed system is capable of providing such functionality (See reasoning applied to Claims 5 and 18), said information is given no patentable weight. MPEP 2106 (II) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a Claim to a particular structure does not limit the scope of a Claim or Claim limitation."

Response to Arguments

Applicant's arguments filed 6/28/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art fails to disclose a ticket examiner which isolates a service providing location from a service-free location, it is noted that Miyashita explicitly teach said feature. Specifically, Miyashita teaches a ticket examining apparatus which, upon determining that the passenger's ticket is invalid, "prohibits the passenger from entering or leaving a

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railroad station" (C. 1, L. 18-19), thereby indicating separation (isolation) of a service providing location (railroad station) by said ticket examining apparatus from a service free location.

In response to applicant's argument that Miyashita fails to teach communication means which conducts communication with a user medium which is mobile, the examiner points out that Miyashita explicitly teaches antenna section 91 where a transmission/reception radio antenna for radio communication with the radio ticket is located, said section is provided on a surface of said ticket examining apparatus (Fig. 1) and based on non-contact electromagnetic contact scheme with a user's radio commuter pass (mobile feature) (C. 3, L. 44-52).

In response to applicant's argument that the prior art fails to disclose that the ticket examiner includes means for issuing a ticket to the user of the user medium which is mobile, it is noted that Sehr was applied for this feature. Specifically, Sehr teaches a passenger station that controls access to a railroad, said station is equipped with smart card reader/writer units (ticket examiners), and a travel center coupled to said station that provides means for issuance of passenger cards (means for issuing a ticket), (Fig. 2; C. 7, L. 25-57). The motivation to combine Miyashita and Sehr would be to provide convenience for the passenger to obtain a new ticket at the gate if a passenger's old ticket is unacceptable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

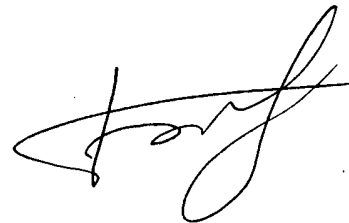
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 703-305-4649. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Igor Borissov
Patent Examiner
Art Unit 3639



IB

8/20/2005